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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,973	08/22/2001	Timothy P. Croughan	98A9-USC1 Croughan	8353

25547 7590 04/09/2007
PATENT DEPARTMENT
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EXAMINER

KRUSE, DAVID H

ART UNIT	PAPER NUMBER
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1638

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/934,973

Applicant(s)

CROUGHAN, TIMOTHY P.

Examiner

David H. Kruse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 62,63,69,71,72,82 and 85-95 is/are pending in the application.
- 4a) Of the above claim(s) 63,69,71,72,82 and 85-95 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of the Application

1. This Office action is in response to the Remarks filed on 26 December 2006.
2. The rejection of claim 62 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement is withdrawn in view of Applicant's arguments.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

4. Claims 63, 69, 71, 72, 82 and 85-95 are withdrawn as directed to an invention non-elected without traverse in the response filed 14 January 2003. Applicant's statement concerning rejoinder on page 3 of the Remarks is noted.

Claim Rejections - 35 USC § 102/103

5. Claim 62 remains rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Terakawa *et al* 1992 (Japan. J. Breed. 42:267-275) taken with the evidence of Bernasconi *et al* 1995 (J. Biological Chemistry 270(29): 17381-17385) and Hattori *et al* 1992 (Molecular and General Genetics 232: 167-173). This rejection is repeated for the reason of record as set forth in the last Office action mailed 23 June 2006. Applicant's arguments filed 26 December 2006 have been fully considered but they are not persuasive.

Applicant argues that Terakawa is not enabling prior art, and that the Office has supplied no evidence of the "commercial availability in enabling form" of Terakawa's seeds, in the words of M.P.E.P. § 2121.03. Applicant argues that the burden is on the

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Office to demonstrate that Terakawa's seeds are commercially available in enabling form. Applicant argues that because it is not enabling, Terakawa neither anticipates the claimed inventions, nor makes them obvious. Applicant state that in compliance with the duty of candor to the Office, the Office is hereby notified that, with some effort, the present inventor has obtained a sample of one of Terakawa's line of seeds. This sample was not obtained commercially. So far as could be determined, the seeds are not sold commercially. Instead, the seed sample was delivered as a courtesy, following a direct personal request from one scientist to another. The process of obtaining the seeds was time-consuming. A not inconsiderable amount of red tape and quarantine procedures were required to import the seed from Japan. It is respectfully submitted that such cumbersome procedures do not satisfy the "commercial availability in enabling form" standard of M.P.E.P. § 2121.03. Seed has now been collected from plants that were grown in quarantine, and the collected seed has been stored. The herbicide resistance characteristics of plants grown from that seed have not been tested by the inventor or his colleagues to date (pages 16 and 17 of the Remarks). These arguments are not found to be persuasive. Applicant's ability to procure seed is evidence that Terakawa is enabling; in addition, one of skill in the art would have been readily able to follow the method of Terakawa in reproducing the disclosed rice plant.

Double Patenting

6. Claim 62 remains rejected under the judicially created doctrine of double patenting over claim 11 of U. S. Patent No. 6,943,280 B2. This rejection is repeated for the reason of record as set forth in the last Office action mailed 23 June 2006.

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Applicant's arguments filed 26 December 2006 are noted but a rejection cannot be held in abeyance (see page 17 of the Remarks).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. No claims are allowed.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David H. Kruse, Ph.D. whose telephone number is (571) 272-0799. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached at (571) 272-0975. The central FAX number for official correspondence is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-1600.

DAVID H. KRUSE, PH.D.
PRIMARY EXAMINER



David H. Kruse, Ph.D.
2 April 2007

10. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

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